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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,579	04/21/2005	Steven D Kloos	1330.012US1	9930
21186 7590 11/07/2007 SCHWEGMAN, LUNDBERG & WOESSNER, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402			EXAMINER MENON, KRISHNAN S	
			ART UNIT 1797	PAPER NUMBER
			MAIL DATE 11/07/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/516,579

Applicant(s)

KLOOS ET AL.

Examiner

Krishnan S. Menon

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-73 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-73 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-73 are pending as amendment by preliminary amendment on 12/2/04.

Specification

The specification has an embedded picture in page 8. This must be removed and presented as a figure with figure number, and also listed under the section, 'Brief Description of Drawings'.

Claim Objections

Claims 16-20,34-38,47,48,51,57,61,65 and 68 recite a term "ÿ", which appears to be a typo for "ß". Correction is required. It is also suggested that applicant review the specification and the claims for consistency in the terminology used.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory

double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 43-47 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-43 of copending Application No. 10/524,155. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of '155 recite all the limitations of the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Uhlinger (US 6,190,556), Lien (US 4,802,982), and/or Robbins (US 6,190,558).

Claim interpretation: this application has a total of 73 claims, 13 of which are independent. These claims are directed at a membrane device, and a combination of

membrane device with a home reverse osmosis system. However the claims are limited to a [spiral wound] membrane device having one or more first and second membrane sheets separated by a permeate carrier, the permeate carrier having certain "H" value. The membrane has certain "A" value and certain " β " value. Claims also recite permeate carrier thickness, And the characteristics of the membrane such as MgSO₄ rejection, lengths and widths of the membrane leaves, etc.

The parameters H, A and β are defined by Lien. Lien also teaches how to optimize these factors for improving the performance of the spiral wound membrane elements.

Uhlinger'556 teaches membrane devices capable of salt rejection >50% (col 8 lines 1-37: discusses monovalent and divalent salts). Even though MgSO₄ is not specifically taught, it would be obvious to one of ordinary skill in the art that MgSO₄ will have similar rejections. Uhlinger'556 teaches the membrane permeability (A value) for reverse osmosis and nanofiltration membranes as ranging from 10 to over 60 (converted from the data of col 2 lines 1-10). Uhlinger'556 does not teach the H and β values, thickness of permeate carrier or leaf length. Lien'982 teaches all these parameters and how to optimize the design based on these parameters (see columns 7-9, tables and working examples). It would be obvious to one of ordinary skill in the art at the time of invention to use the teachings of Lien'982 in the teaching of Uhlinger'556 to optimize the membrane device design for the desired performance. Even though none of these references teach specifics of leaf length and the number of leaves, leaf length and the number of leaves are variables that one of ordinary skill is capable of

optimizing to provide the required membrane area for the desired permeate (product water) flow. The cross flow velocity of the feed is a process parameter, which has no structural relationship with the device claimed, and one of ordinary skill in the art is also capable of optimizing flow velocity from the feed quality, and the device specifics to minimize the pressure drop.

Claims 39-47: Robbins'556 teaches a tankless home reverse osmosis system comprising spiral wound element which provides at least 150 gallons/day of permeate flow (see abstract, column 4 lines 1-36 and col 6 lines 5-12). The A value is greater than 25 (calculated from pressure, flow and membrane area). This system can operate at <30 psi driving pressure. Re the salt rejection, the system is expected to give >90% NaCl rejection, even though the reference does not provide such details. Uhlinger teaches membrane elements that provide such kind of rejections (col 8 lines 1-15). Lien'982 teaches A and β values and how to optimize the device design. The dimensions of the membrane device depend on the permeate flow required, and one of ordinary skill in the art would be capable of designing it.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S. Menon whose telephone number is 571-272-1143. The examiner can normally be reached on 8:00-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Krishnan S Menon
Primary Examiner
Art Unit 1797